

Appl. No. 09/660,162
Atty. Docket No. 7886
Amdt. dated November 18, 2003
Reply to Office Action of August 18, 2003
Customer No. 27752

REMARKS

Claims 1-6, 9-41 are pending in the present application. No additional claims fee is believed to be due.

Claims 42 and 43 remain withdrawn without prejudice due to the election/restriction requirement of November 14, 2002.

Claims 7 and 8 have been canceled without prejudice.

Claims 1, 5 and 31 have been amended to more clearly claim the invention of the present application. Claim 1 has been amended to more specifically claim the present invention. Support for the amendment of Claim 1 is discussed in more detail below. Claim 5 has been amended as suggested by the Office Action. Support for the amendment of Claim 31 is found at page 14, lines 18-27 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Objection Under 35 U.S.C. §132

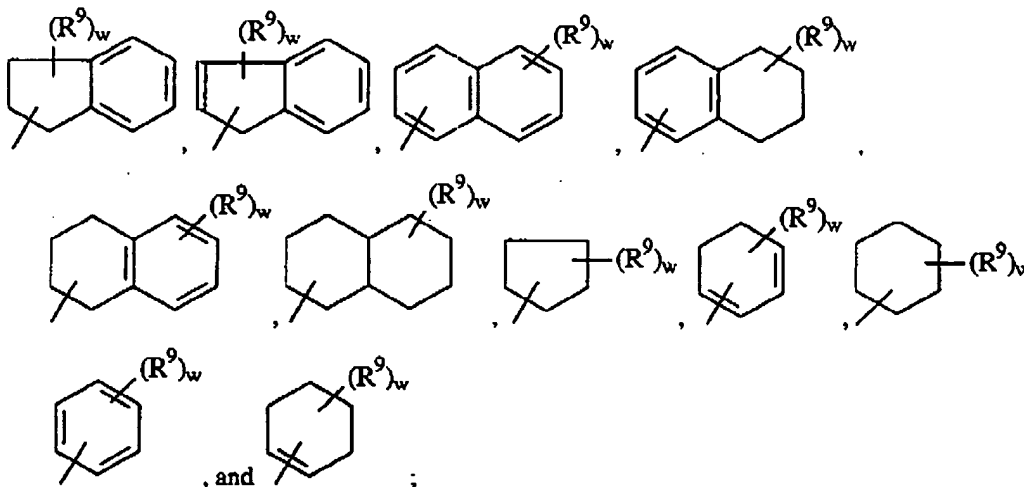
The Office Action states that the amendment filed June 9, 2003, is objected to under 35 U.S.C. §132 for introducing new matter. The newly added groups (ii)-(v) for the variable R₂ in instant Claims 1, 6, and 16.

Applicants submit support in the specification for Claim 1 groups (ii)-(v) as follows:

(ii) 4 to 30 membered substituted or unsubstituted, unsaturated cyclic or aromatic hydrocarbon radical

Page 9, lines 7-16, wherein R² is $\text{---}(\text{CH}_2)_y\text{---X}$; y=0, and X is selected from the group consisting of:

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wherein each R⁹ is independently selected from the group consisting of hydrogen, linear or branched, saturated or unsaturated, substituted or unsubstituted, aliphatic hydrocarbon or alkoxy radical having from about 1 to about 10 carbon atoms, or R⁹ is a saturated or unsaturated, substituted or unsubstituted, alicyclic or aromatic hydrocarbon radical having, from about 1 to about 10 carbon atoms, which is fused to the ring; w is an integer from 1 to 3..

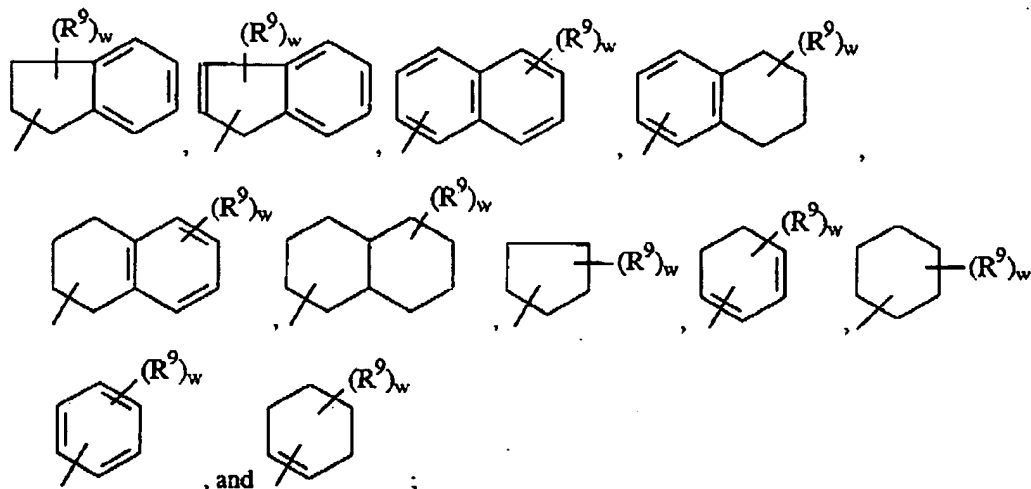
(iii) 7 to 13 membered substituted, or unsubstituted polycyclic ring

Page 9, lines 1-6

(iv) substituted or unsubstituted saturated cyclic hydrocarbon radical having from 5 to 30 carbon atoms, wherein when the cyclic hydrocarbon radical is an unsubstituted 6 carbon radical or a substituted 7 or 8 carbon radical, R is a linear or branched, saturated or unsaturated, substituted or unsubstituted aliphatic radical having from about 1 to about 5 carbon atoms

page 9, line 7 – page 10, line 4, wherein R² is $\text{---}(\text{CH}_2)_y\text{---X}$; y=0, and X is selected from the group consisting of:

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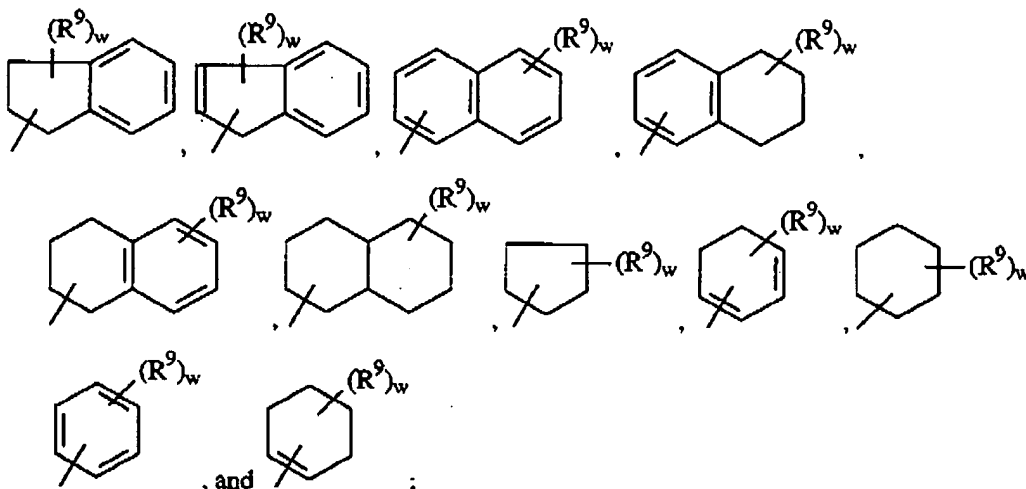
wherein each R^9 is independently selected from the group consisting of hydrogen, linear or branched, saturated or unsaturated, substituted or unsubstituted, aliphatic hydrocarbon or alkoxy radical having from about 1 to about 10 carbon atoms, or R^9 is a saturated or unsaturated, substituted or unsubstituted, alicyclic or aromatic hydrocarbon radical having, from about 1 to about 10 carbon atoms, which is fused to the ring; w is an integer from 1 to 3.

Page 4, lines 1-4.

(v) substituted or unsubstituted saturated cyclic hydrocarbon radical having from 5 to 30 carbon atoms, wherein when the cyclic hydrocarbon radical is an unsubstituted cyclohexyl radical or a methyl or ethyl substituted cyclohexyl radical, R is a branched, saturated or unsaturated, substituted or unsubstituted aliphatic radical having from about 23 to about 30 carbon atoms

page 9, line 7 – page 10, line 4, wherein R^2 is $-(CH_2)_y-X$, $y=0$, and X is selected from the group consisting of:

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wherein each R⁹ is independently selected from the group consisting of hydrogen, linear or branched, saturated or unsaturated, substituted or unsubstituted, aliphatic hydrocarbon or alkoxy radical having from about 1 to about 10 carbon atoms, or R⁹ is a saturated or unsaturated, substituted or unsubstituted, alicyclic or aromatic hydrocarbon radical having, from about 1 to about 10 carbon atoms, which is fused to the ring; w is an integer from 1 to 3.

And Page 4, lines 1-4 for the description of the R moiety.

Applicants submit that Claim 6 has support in the specification at page 5, lines 17-22.

Applicants submit that Claim 10 has support in the specification at page 5, lines 17-22.

Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action States Claims 1-23 are rejected under 35 U.S.C. §112, First Paragraph as failing to comply with the written description requirement. Specifically, the newly added groups (ii)-(v) for the variable R^2 in instant claims 1, 6, and 10.

An applicant's specification must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, i.e., whatever is now claimed. Vas-Cath, Inc. v. Mahurkar, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." Ralston Purina Co. v. Far-Mar-Co., Inc., 227 USPQ 177, 179 (Fed. Cir. 1985). The subject matter of the claim need not be described literally (i.e., using the same terms

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or in *haec verba*) in order for the disclosure to satisfy the description requirement. See MPEP §2163.02. The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 191 USPQ 90, 96 (CCPA 1976). The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 191 USPQ at 98.

Applicants submit that the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, what was in possession of the invention, i.e., whatever is now claimed. In the decision of *Ex parte Sorenson*, 3 USPQ2d 1462 (Bd. Pat. App. & Inter. 1987), it was decided that the subgeneric language of "aliphatic carboxylic acid" and "aryl carboxylic acid" did not violate the written description requirement because species falling within each subgenus were disclosed as well as the generic carboxylic acid. Similarly, Applicants submit that the narrowing of Claim 1 for the claim of the R² moiety from:

(ii) linear or branched, saturated or unsaturated, substituted or unsubstituted, cyclic or acyclic, aliphatic or aromatic hydrocarbon radicals having from about 1 to about 30 carbon atoms;

to claim the subgeneric language of:

(ii) unsaturated cyclic or aromatic hydrocarbon radicals having from about 4 to about 30 carbon atoms; and

(iii) 7 to 13 membered substituted, or unsubstituted polycyclic ring;

(iv) substituted or unsubstituted cyclic hydrocarbon radical having from 5 to 30 carbon atoms, wherein when the cyclic hydrocarbon radical is an unsubstituted 6 carbon radical or a substituted 7 or 8 carbon radical, R is a linear or branched, saturated or unsaturated, substituted or unsubstituted aliphatic radical having from about 1 to about 5 carbon atoms; and

(v) substituted or unsubstituted cyclic hydrocarbon radical having from 5 to 30 carbon atoms, wherein when the cyclic hydrocarbon radical is an unsubstituted cyclohexyl radical or a methyl or ethyl substituted cyclohexyl radical, R is a branched, saturated or unsaturated, substituted or unsubstituted aliphatic radical having from about 23 to about 30 carbon atoms;

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Such that the subspecies of (ii)-(v) are within the generic description of original subgroup (ii) and original R moiety definition. With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. Applicants submit that the numerical range limitations are ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. Therefore, Applicants submit that the Examiner has failed to present a prima facie case for failing to comply with the written description requirement.

Applicants further submit that Claims 6 and 10 are also contain subgeneric language of the original generic subgroup wherein R^2 is a hydrocarbon radical of the formula:



wherein the generic description of R^3 is an aliphatic radicals or aromatic hydrocarbon radicals having from about 1 to about 30. Claims 6 and 10 claims an amended subgeneric R^3 as a cyclic aliphatic radicals having from about 5 to about 30 carbon atoms or aromatic hydrocarbon radicals having from about 6 to about 30 carbon atoms. Applicants submit that the subgeneric R^3 is recognizable by one of skill in the art. Applicants further submit that the numerical range limitations are ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. Therefore, Applicants submit that the Examiner has failed to present a prima facie case for failing to comply with the written description requirement.

Double Patenting Rejection

The Office Action has maintained rejected Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of Claims 1-7 of US 6,506,945. Applicants will submit a terminal disclaimer to overcome the double patenting rejection of Claims 1-37, if and when the Examiner indicates allowable subject matter.

Conclusion

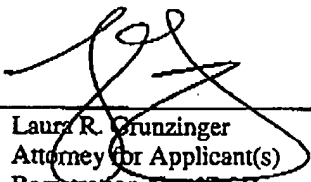
In light of the above remarks, it is requested that the Examiner reconsider and withdraw the objection and rejection under 35 U.S.C. § 132 and §112, first paragraph. Early and favorable action in the case is respectfully requested.

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Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-6 and 9-41. If, prior to allowance, any outstanding issues exist, Applicants' attorney would welcome the opportunity to resolve such issues via a phone interview.

Respectfully submitted,

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